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10/785,237

02/24/2004

Yves Millou

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

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07/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/785,237 | Applicant(s) MILLOU ET AL. | |
| | Examiner GINA C. YU | Art Unit 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8,10 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,10 and 14-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendment and declaration filed on April 9, 2008.

Claims 1-3, 5-8, 10, 14-22 are pending. Claim rejections made under 35 U.S.C. § 102 (b) is withdrawn in view of Declaration filed on April 9, 2008. New rejections are made as below.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 8, 14-16, 20, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amrita ("Helichrysum italicum", 1999, XP002224497).

The Amrita online disclosure indicates that the essential oil of *Helichrysum italicum*, grown in high altitudes and dry, sunny spots in Mediterranean region, has been commercially available as of 1999. The reference teaches that the essential oil is distilled from the flower part, meeting instant claim 2. The reference also teaches that the essential oil is added to skin care products for skin-rejuvenating properties. See instant claim 8. The claimed methods of 14-16, 22-24 are obvious results of practicing the prior art as intended.

Since the prior art *Helichrysum* essential oil is obtained from the same source as the presently claimed invention, the prior art essential oil inherently contains the same components as required by instant claim 4. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See *In re Best*, at 1255, 433. "When the PTO shows a sound basis

for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." See *In re Spada* at 709, 1658.

In this case, applicant's declaration filed on April 9, 2008 indicates that the prior art essential oil contains 35.57 % of neryl acetate. This amount is close to "about 40%". The prior art teaches Helichrysum essential oil obtained from the same source by same method as claimed by applicant, and contains neryl acetate in an amount close to the claimed range. Examiner views that there is no patentable distinction between the claimed composition and the prior art.

Claims 5, 6, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amrita ("Helichrysum italicum", 1999, XP002224497) as applied to claims 1-3, 8, 14-16, 20, 22-24 as above, and further in view of Spina (Derwent ACC. No. 1999-471299, English abstract of FR 2774585).

Amrita does not specifically mention the weight amount of the Helichrysum italicum oil in the cosmetic compositions.

Spina discloses a topical composition for scalp, which comprises Helichrysum italicum essential oil. See Abstract, Novelty; instant claims 1, 2, and 8. The abstract also teaches that the composition has anti-inflammatory, wound healing, and antiseptic effect. With respect to claim 5, the French patent indicates that 1.1-1.3 g of Helichrysum italicum essential oil is used in 30 g of total preparation, which is equivalent to 3.7-4.3 wt %. See '585, p. 1, line 21; p. 2, component 3; instant claim 5.

Given the general teaching of the Amrita to make a topical formulation comprising Helichrysum italicum oil, the skilled artisan would have been motivated to look to the prior

arts such as Spina for a more specific teachings on the amount of the active ingredient suitable for topical application. Furthermore, given the teaching of the specific functions of the essential oil (i.e., rejuvenation effect), the skilled artisan would have discovered a workable range of the active ingredient by routine experimentations.

Claims 7 10, 19, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amrita as applied to claims 1-3, 8, 14-16, 20, 22-24 as above, and further in view of Afirat et al. (US2002/0119954 A1).

Amrita does not teach the nanospheres formulation of instant claim 7 or the additives of instant claim 10.

Afirat teaches cosmetic composition comprising ascorbic acid, and also teaches that moisturizing active agents, in case of incompatibility with other materials, are incorporated into nanospheres in order to isolate them from each other in the composition. See p. 3-4, [0061]. Essential oils and vitamin E are taught. See instant claim 10.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teaching of Amrita by incorporating Helichrysum italicum essential oil and/or vitamin E into nanospheres, as motivated by Afirat, because both inventions of Amrita and Afirat are in cosmetic art, and Afirat teaches that it is well known in cosmetic art to incorporate essential oils or vitamin E moisturizing agent in nanospheres for stability of the composition and separation of the active ingredients during the storage. The skilled artisan would have had a reasonable expectation of successfully producing a stable composition comprising Helichrysum italicum in nanospheres.

Oath/Declaration

Declaration filed on April 9, 2008 has been fully considered but does not place the application in allowable condition.

The declaration shows chromatography data which shows that the essential oil composition of Amrita contains 35.57 % of neryl acetate. While the data overcomes the anticipation rejection made under 35 U.S.C. 102(b), the claimed limitation "about 40 %" is still within an obvious range of the amount of neryl acetate in the prior art essential oil.

Response to Arguments

Applicant's arguments filed on April 9, 2008 have been fully considered but they are moot in view of new grounds of rejection in part, and not persuasive in part.

Rejection made under 35 U.S.C. 102(b)

Applicant's arguments are moot as the rejection has been withdrawn in view of the 132 declaration as discussed above.

Rejection made under 35 U.S.C. 103(a) as unpatentable over Amrita and Spina

Applicant argues that Amrita does not disclose essential oil comprising 40-70% of neryl acetate by weight. As discussed above, the prior art contains 35.57 % of neryl acetate which is close to "about 40%".

Rejection made under 35 U.S.C. 103(a) as unpatentable over Amrita and Afriat

Applicant argues that Amrita does not disclose essential oil comprising 40-70% of neryl acetate by weight. As discussed above, the prior art contains 35.57 % of neryl acetate which is close to "about 40%".

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/
Primary Examiner, Art Unit 1617